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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,687	07/14/2005	Richard David Saunders	UDL27.001APC	8588
20995 7590 12/10/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER BURNLEY, RACHEL L				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
12/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/539,687

Applicant(s)

SAUNDERS ET AL.

Examiner

Rachel L. Burney

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5905012, De Meutter et al. De Meutter discloses a toner particle which comprises a toner resin in a liquid (column 6, lines 19-35) and further comprises a reactive group which is added to the toner particle, which reacts with a reactive group in a substrate to form chemical bonds to the substrate (column 5, line 63 - column 6, line 7).

3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5516362, Gundjian et al.

With respect to claims 1-7, Gundjian discloses a printing medium to which is added a reactive marking composition (column 1, lines 44-60), wherein the printing medium may be a toner (column 2, lines 36-40). The composition is mixed with the printing medium in a solution with a binder (column 3, lines 14-16). The

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composition may be 3,3-bis (4-dimethylaminophenyl)-6-dimethylaminophthalide (column 5, lines 13-15), which is the security ingredient of the instant application, and would therefore have all the properties of the security ingredient. Claims 1-7 are drawn to the liquid toner, the reaction with the substrate does not impart any patentable weight to the toner composition.

With respect to claim 8, Gundjian further discloses that the toner comprises a second composition (column 1, lines 53-60).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5427886, Miller et al. in view of US Patent 6051305, Hsu.

With respect to claims 1-7, 9-14, Miller discloses a process for forming an image comprising providing microcapsules in an aqueous manufacturing vehicle including enwrapped capsule core materials comprising a chromogen and a photosensitive composition, wherein the capsules are adhered to the surface of a substrate with a binder material, then the microcapsules are ruptured on the

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substrate allowing the chromogen to react with an acid developer (column 1, lines 36-60). The photosensitive composition may be a toner (column 6, lines 23-25), the chromogen may be 3,3-bis(4-dimethylaminophenyl)-6-dimethylaminophthalide (column 6, lines 45-67), and the acid developer may be treated clays, aromatic carboxylic acids or metal salts thereof, or phenolic resins (column 7, line 65 – column 8, line 7). Miller fails to teach the digital press system of the instant application. Hsu discloses digital presses (column 1, lines 20-26) which use liquid toners (column 5, lines 56-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the any known imaging composition in the press of Hsu, including that of Miller, and one would have a reasonable expectation of success in doing so.

With respect to claim 15, Miller further discloses that the substrate may be paper (column 6, lines 1-10).

Response to Arguments

6. Applicant's arguments, see pages 5-7, filed 07/29/2008, with respect to the rejection(s) of claim(s) 1-8 and 16 under Nagashima and 9-15 under Nagashima and Hsu have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark F. Huff/
Supervisory Patent Examiner, Art Unit 1795

RLB